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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY,DOCKET NO.	CONFIRMATION NO.
09/544,669	04/06/2000	Haruo Machida	35.C14411	9175
5514	7590	11/28/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LEE, YAONENG	
			ART UNIT	PAPER NUMBER
			2624	
DATE MAILED: 11/28/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/544,669	MACHIDA, HARUO
	Examiner	Art Unit
	Yaoneng Lee	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-80 is/are rejected.
- 7) Claim(s) 1-28 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 April 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character S905 has been used to designate both the "Change icon to show valid device" block and the "All device checked" decision block in Fig. 10. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character 4 in Fig. 33 has been used to designate both information in a shared device and information in a non-shared device. Furthermore, "Information" of non-shared device in specifications is assigned a numeral "4" while in Fig. 33, the same element is assigned numeral "2". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Above are only a few examples of incorrect or missing reference citations in the specification and drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

1. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

- a. P 26, line 17. "Own machine" within "device drivers installed in the *own machine*" was not assigned a reference number, where previously it was assigned 302c in Fig. 3.
- b. P30, line 26. Copy function setup panel not issued a reference number. Uncertain if copy function setup panel described exists within specification.
- c. P 23, line 24. Function data is assigned a reference no. of 693c instead of 603c in Fig. 6.
- d. P 25, line 13-16. Incomplete/structurally bad sentence.
- e. P 28, line 23. Copier icon mislabeled as 401a. Correct reference number should be 301a.
- f. P 93, line 17. Unclear description of position of first icon in the *left side*.
- g. P93, line 23. Wrong reference block in process step S5214 in Fig. 52. Fig. 52 shows that step advances to S2514 instead of S2515.
- h. P 88, line 23-25. Unclear statement due to bad sentence structure.

- i. Furthermore, there exists a blank vertical strip which inhibits examiner to view significant information in the specification and claims, throughout the disclosure.

Appropriate corrections are required.

Claim Objections

3. Claims 1-28 are objected to because of the following informalities:

Appropriate correction is required.

Claim statements are partially erased by white vertical strip prohibiting examiner to view important claim dependencies.

4. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because the numbering of dependencies in the claims are unreadable due to the blank strip across numerous pages throughout the specification. The applicant is strongly advised to submit a camera-readable copy of the entire specification.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 61-80 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claims 61-80 classified under mathematical algorithms are non-statutory subject matter as the program claimed is a process that manipulates abstract ideas or concept.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 13-20, 21-26, 33-40, 41-46, 53-60, 61-66 and 73-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklut et al. (5790119) (hereinafter as Sklut) in view of Kuwamoto et al. (5353399) (hereinafter as Kuwamoto).

Regarding claim 1, Sklut discloses an information processing apparatus which comprises means for obtaining status and connection information (col. 20 line 26-53, Fig. 13, **status** displayed on screen);

means for designating the combination of any of icons representing peripheral devices and services on a graphical display (col. 18 line 25-35, Fig. 13, ref. no. 304 and 284 has a combination of printer and scanner selected in step ref. no. 198 and 208 of

Fig. 9, wherein the metaphor elements in Sklut refers to graphical icons representing information processing devices according to col. 7, line 58-63);

means for determining the validity of combining functions (col. 21, line 64-col. 22 line 2 and col. 23 line 65-col. 24 line 2, wherein a device in the second selection in the combination is determined for compatibility for use with a device in the first selection;

means for displaying a control setup screen for the combined functions (Fig. 13 shows the combination of devices that can be selected by the user in step ref. no. 198 of Fig. 9, who thereafter selects the attributes from the device attribute display according to step ref. no. 200, 202 and 204, where device attribute sets can also be modified according to col. 15 line 58-col. 16 line 10).

Sklut does not disclose expressly a means for displaying the system configuration on a display with icons based on said connection information and status information.

However, Kuwamoto discloses means for obtaining connection information and status information about network peripheral devices (Fig. 14, appended with icon 451, 457 etc. are the status display information such as UNUSABLE, col. 13, line 42-48); and means for displaying the system configuration on a display with icons based on said connection information and status information (Fig. 14 ref. no. 470, 451, 456, 457 and 458, col. 12 line 54-59).

Kuwamoto and Sklut are combinable because they are from the same field of endeavor, information processing systems with graphical user interface to control the workflow of peripheral devices in a network.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Kuwamoto and Sklut; the display of the system configuration comprising all the network components devices of Kuwamoto replacing the pull down menus of Sklut (col. 18 line 19-23).

The motivation for doing so would have been to make the job programming system of Sklut user friendlier. By displaying the system configuration on the user interface of Sklut, Kuwamoto allows the user to visually capture the available component devices on the screen in a single view. This is an improvement to the user interface program of Sklut, as it provides ease of use when selecting devices for input/output functions.

Therefore, it would have been obvious to combine Sklut with Kuwamoto to obtain the invention as specified in claim 1.

Regarding claims 2-3, Sklut discloses control means for adjusting the attributes of the peripheral devices (referred to in Sklut as metaphor elements) involving said combination of designated icons, each icon equivalent to a metaphor element (col. 19 line 60-col. 20 line 10, col. 21 line 48-col. 22 line 9, Fig. 11, reference no. 246-248), in which said control means control peripheral devices based on parameter inputs (or attribute settings according to Sklut) in said setup screen (Fig. 11, ref. no. 252, 256 and 258).

Regarding claim 4, Sklut discloses a scanner icon (Fig. 12, reference no. 282) and a printer icon (Fig. 12, ref. no. 284), designated in a metaphor combination, with

image data inputted to said scanner and corresponding image data to be output on said printer (Fig. 12 ref. no. 280, 282, 284 and 300, col. 9, line 29-47).

Regarding claims 5-6, Sklut discloses a system display means that modifies the appearance of designated icons for valid functions with a screen display in Fig. 12 that shows an exemplary metaphorical workflow representation. Under ref. no. 282 and 284, the dotted line box encompassing “scanner 1” and “North Printer” shows the designated device by the user.

Regarding claims 13-16, Sklut discloses means for obtaining (or downloading described in Sklut) information of said peripheral device designated by the user (Fig. 7 ref no. 146-152, col. 14 line 32-42); a system of plural data processing apparatuses capable of performing data communication with each other, each connected to a predetermined communication medium (Fig. 7 ref no. 146 and notice several references of no. 112 in Fig. 6 describing an application server in Sklut), wherein any of data processing apparatus is assigned as a management server from which status and connection information is obtained (Fig. 7 ref. no. 146-166, Fig. 11 ref. no. 246-252, col. 20 line 3-28).

Regarding claims 17-20, Sklut’s data processing system of peripheral devices includes a printer (col. 13 line 39), a facsimile (col. 13 line 40), a scanner and a digital copier (col. 13 line 36).

Regarding claims 21-26, 33-40, the data processing apparatus of Sklut includes a means for performing the steps of method claims 21-26, 33-40 (col. 24 line 59-col. 26

line 21). The limitations of method claims 21-26, 33-40 are wholly covered by the limitations of the apparatus claims 1-6, 13-20.

Regarding claims 41-46, 53-60, as described above, the system of Sklut comprises a computer readable memory medium in which the application is stored (Fig. 5 ref. no. 44). Sklut's information processing system comprises of a network service module which includes a computer readable memory medium such as a Motorola Power PC processor or controller (Fig. 5 ref. no. 44) and a host memory (ref. no. 74). The limitations of the apparatus claims 21-26, 33-40 wholly covers the limitations of the computer readable memory medium claims wherein the computer memory stores a computer program which executes the steps of method claims 21-26, 33-40.

Regarding claims 61-66 and 73-80, as mentioned above, Sklut's control program performs the above processes according to the limitations of the method claims 21-26, 33-40 (Fig. 6 ref. no. 142).

7. Claims 8-9, 11-12, 28-29, 31-32, 48-49, 51-52, 68-69 and 71-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklut in view of Kuwamoto as applied to claims 1, 21, 41 and 61 and further in view of Sugiyama et al. (5996029) (hereinafter as Sugiyama).

Sklut and Kuwamoto are relied upon for the teachings as discussed above relative to claim 1. However, neither Sklut nor Kuwamoto discloses parameter determination means for determining a parameter involving said combined functions; setup screen display means to display setup functions based on parameter settings,

determination means that determinesies a choice of copy modes between color or monochrome and paper size.

Regarding claims 8-9, Sugiyama discloses an information control apparatus that has parameter determination means for determining a parameter involving selected functions (Fig. 90 ref. no. BT4, col. 75 line 30-41 wherein the designating window in Fig. 90 allows the user to select the type of device or function and the parameter setting window of Fig. 91 allows the user to set the parameters of the selected device or function).

Regarding claims 11-12, Sugiyama's apparatus possesses determination means to determine a choice of two copy modes, color or monochrome (Fig. 91 ref. no. BT4) and paper size (Fig. 91 ref. no. BT5, col. 75 line 42-45).

It would have been obvious to one of ordinary skill in the art of graphical user interface control programs at the time of invention to incorporate the parameter setting capability which includes options for setting paper size and copy mode, of Sugiyama's information processing control system with that of Sklut. Both relate to the same functions of handling input and output jobs comprising scanning and printing devices and Sugiyama's control settings can be seen as an extension of Sklut's apparatus.

Regarding claims 28-29 and 31-32, the data processing apparatus of Sklut includes a means for performing the steps of method claims 28-29 and 31-32 (col. 24 line 59-col. 26 line 21). The limitations of method claims 28-29 and 31-32 are covered wholly by the limitations of the apparatus claims 8-9 and 11-12.

Regarding claims 48-49 and 51-52, the system of Sklut comprises a computer readable memory medium in which the application is stored (Fig. 5 ref. no. 44). The limitations of the apparatus claims 28-29 and 31-32 wholly covers the limitations of the computer readable memory medium claims wherein the computer memory stores a computer program which executes the steps of method claims 28-29 and 31-32.

Regarding claims 68-69 and 71-72, Sklut's control program performs the above processes according to the limitations of the method claims 28-29 and 31-32 (Fig. 6 ref. no. 142).

8. Claims 10, 30, 50 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklut in view of Kuwamoto as applied to claims 1, 8, 21, 28, 41, 48, 61 and 68 and further in view of Unishi et al. (6147770) (hereinafter as Unishi).

Regarding claim 10, Sklut and Kuwamoto are relied upon for the teachings as discussed above relative to claim 1 and 8. However, neither Sklut nor Kuwamoto discloses determination means to determine the resolution of a copy function based on the resolution of said scanner and resolution of said printer as required by claim 10.

Unishi discloses the resolution of the copy output function of a scanner and printer combination function based on the resolution of the scanner and printer (col. 7 line 50-col. 8 line 6).

The incorporation of the determination means of Unishi to determine resolution of the copy function to the scanner input and printer output combination made obvious by Sklut and Kuwamoto would have been obvious to those of ordinary skill in the art of

printing resolution at the time of invention by applicant as resolution of the input data from the scanner cannot be higher than the maximum allowable output resolution of the printer as this would constitute a conflict in the output printing operation when the input data from the scanner is sent to the printer.

Regarding claim 30, the data processing apparatus of Sklut includes a means for performing the steps of method claim 10 (col. 24 line 59-col. 26 line 21). The limitations of method claim 30 are covered wholly by the limitations of the apparatus claims 10.

Regarding claim 50, the system of Sklut comprises a computer readable memory medium in which the application is stored (Fig. 5 ref. no. 44). The limitations of the apparatus claims 30 wholly covers the limitations of the computer readable memory medium claims wherein the computer memory stores a computer program which executes the steps of method claims 30.

Regarding claim 70, Sklut's control program performs the above processes according to the limitations of the method claims 30 (Fig. 6 ref. no. 142).

9. Claims 7, 27, 47 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklut in view of Kuwamoto as applied to claims 1, 21, 41, 61 and further in view of Komiyama (6011553).

Regarding claim 7, Sklut and Kuwamoto are relied upon for the teachings as discussed above relative to claims 1, 21, 41 and 61. However, neither Sklut nor Kuwamoto discloses a system display that displays an image indicating that data is being transferred from a scanner to a printer.

Komiyama however, discloses a method of transferring and displaying data in a graphical user interface that displays the transfer of data from a source icon to a destination icon within the computer system (Fig. 15, ref. no. 15 and 18, col. 8, line 60-67), where the destination icon represents a printer (Fig. 15, ref. no. 21).

Although Komiyama does not state the transfer of image or data directly from a scanner to a printer, it can be interpreted from Komiyama's disclosure that a source object and destination object can comprise any computer peripheral device that has storage capacity. The utilization of Komiyama's display of data transfer to the scanner input and printer output function made obvious by Sklut and Kuwamoto would have been obvious to those of ordinary skill in the art of graphical user interfaces at the time of invention by applicant as having a visual display of the transfer operation would make the information processing system of Sklut and Kuwamoto more user-friendly and efficient, allowing the user to easily keep track of the progress of the data transfer. A user who is executing a data transfer function can instantly attempt to correct a problem when he notes a break in the data transfer operation via the visual display.

Regarding claim 27, the data processing apparatus of Sklut includes a means for performing the steps of method claim 7 (col. 24 line 59-col. 26 line 21). The limitations of method claim 27 are covered wholly by the limitations of the apparatus claims 7.

Regarding claim 47, the system of Sklut comprises a computer readable memory medium in which the application is stored (Fig. 5 ref. no. 44). The limitations of the apparatus claims 27 wholly covers the limitations of the computer readable memory

medium claim 47 wherein the computer memory stores a computer program which executes the steps of method claim 27.

Regarding claim 67, Sklut's control program performs the above processes according to the limitations of the method claim 27 (Fig. 6 ref. no. 142).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaoneng Lee whose telephone number is (703)305-8670. The examiner can normally be reached on 8.00am-4.30pm (Mon-Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 7033087452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-9700.



28 October 2003

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